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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,136	10/12/2001	Wolfgang Reik	3191/OJ838	7044
7278	7590	01/13/2004	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			SMITH, JULIE KNECHT	
			ART UNIT	PAPER NUMBER
			3682	
DATE MAILED: 01/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,136

Applicant(s)

REIK ET AL.

Examiner

Julie K Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7-8 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardeman et al. (5,267,488) in view of Machida et al. (4,719,812).

Regarding claims 1-5, Hardeman et al. discloses a motor vehicle (V) comprising an engine with an engine block, a clutch (12) with a clutch actuator device, the clutch actuator device including a clutch release device (36) with a clutch release drive source (62). Hardeman et al. further discloses a transmission (46) adjacent to the clutch, a transmission housing, a clutch bell housing (28), a control device and a carrier element (10), wherein the transmission housing is connected to the clutch bell housing and the clutch bell housing is connected to the engine block (see fig. 1). Hardeman et al. further discloses said carrier element arranged in an intermediate area between the clutch bell housing and the transmission housing (see fig. 3). The clutch release drive source and the clutch release device are both integrated in the carrier element (see col. 5, lines 5-8). The adapter housing of Hardeman et al. is not used in an automatic transmission, as claimed, and is silent as to hydraulic elements being integrated within the housing. However, Machida et al. teaches an automatic transmission adapter having a clutch

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actuator device (3) comprising hydraulic conduits and hydraulic elements, such as a valve and cylinder (11, 12, 13, 17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the housing of Hardeman with the teachings of Machida et al. to modify the housing of Hardeman et al. to be used in an automatic clutch and further, to replace the mechanical elements with hydraulic components, as it is old and well known in the art that hydraulic elements are found in clutch housings, along with mechanical and electrical components.

Regarding claims 7-8, Hardeman discloses a carrier element (10) that functions as a rear wall that closes off the clutch bell housing towards the transmission. Hardeman further discloses a clutch bell housing (28) comprising a rear housing wall (22) and the carrier element is arranged to lie against the rear housing wall.

Regarding claim 12, Hardeman discloses the clutch bell housing (28) and the transmission housing being made as separate components and the carrier element forms a connection between the housings.

Regarding claim 13, Hardeman discloses the clutch bell housing and the transmission housing being connected as a housing unit and the carrier element is arranged inside the housing unit in a transition area between the clutch bell and transmission housing (see fig. 3).

Regarding claims 14-16, Hardeman discloses a carrier device (10) forming an assembly unit that is preassembled. Claims 14-16 are product-by-process claims and are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the

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product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

3. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardeman in view of Machida et al. as applied to claims 1-5, 7-8 and 6-12 above, and further in view of Burkett (5,566,591). Hardeman discloses a carrier element, as claimed, but is silent as to the manufacture of the housing. However, Burkett teaches a carrier element (28) made as a steel casting (see col. 6, lines 26-31). Burkett further teaches actuator parts that are integrally molded into the casting.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the carrier element by casting as it is old and well known in the art to use casting as a method of manufacture.

Moreover, claims 9-11 are product-by-process claims and are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Response to Arguments

4. Applicant's arguments filed 10/12/01 have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the

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references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, although the adapter housing of Hardeman et al. is found in a manual transmission, the housing itself would be operable if placed in an automatic transmission.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Smith whose telephone number is 703-305-3948. The examiner can normally be reached on Monday-Friday, 8-5:30, (Every other Friday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Jks

Jks

January 8, 2004


DAVID A. BUCCI 1/12/04
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600